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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/048,040	01/24/2002	Wolter Ten Hoeve	NL 010357	1130

7590 11/19/2004

Corporate Patent Counsel
Philips Electronics North America Corporation
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EXAMINER

TESKIN, FRED M

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/048,040

Applicant(s)

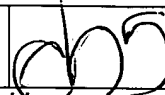
TEN HOEVE ET AL.

Examiner

Fred M Teskin

Art Unit

1713



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on October 20, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 4-6 and 9-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12402</u> . | 6) <input type="checkbox"/> Other: _____ |

Claims 1-14 remain pending herein.

Applicant's election with traverse of the invention of Group I, claims 1-8, identified as species (I), in the reply filed on October 20, 2003, is acknowledged. The traversal is on the ground(s) that "the device and the method for making it are so closely related that searching both the device and the method would not impose an undue burden on the Examiner". (Response, p. 2). This is not found persuasive because it merely states conclusions and does not in any way relate to the examiner's reasons – distinctness and separate classification – for insisting upon restriction. Applicant must so point out the nature of such relationship as to overcome the reasons advanced by the examiner. Furthermore, searching is not the only element of burdensomeness. Different issues of patentability would be burdensome. One of the inventions might be patentable and the other invention(s) unpatentable, causing extended prosecution resulting in significant delays in the issuance of the patent.

The requirement is still deemed proper and is therefore made FINAL.

Claims 4-6 and 9-14 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species and a nonelected invention, respectively, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on October 20, 2003.

Art Unit: 1713

The references cited in the Search Report mailed October 10, 2001, have been considered, but will not be listed on any patent resulting from this application because they were not provided on a separate list in compliance with 37 CFR 1.98(a)(1). In order to have the references printed on such resulting patent, a separate listing, preferably on a PTO-1449 form, must be filed within the set period for reply to this Office action.

Claims 1, 2, 3, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-3, 7 and 8 are indefinite due to improper Markush language in the various recitations of (i) "chosen from among ...", (ii) "chosen from the group of ..." and (iii) "chosen from the group comprising ...". See the definition of variables for claim formulae (I)-(V). The presence of open language in recitation (iii) renders the scope of the group indeterminate. The use of proper Markush language, viz., "selected from the group consisting of ..." is suggested; see MPEP 2173.05(h).

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

Art Unit: 1713

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 4900782 to Han et al.

Claim 7 is drawn to polymers with structural units having the defined formula (I), and characterized in that the polymers have an average chain length of at least 50 and at most 1000 units.

Han et al differ from claim 7 only in that a polymer having the $S(O)_tR_1$ leaving group of formula (I) and the requisite chain length is not shown in a single embodiment.

Nevertheless, Han et al identify species of the $S(O)_tR_1$ moiety, among other moieties, as suitable examples of the leaving group D in polymer formulae which otherwise correspond to claim formula (I). See column 3, formulae II – VI and lines 65-68 as well as column 7, lines 6-12 where D is defined as inclusive of moieties of the formula $-SOR_1$ and $-SO_2R_1$ where R_1 can be, e.g., alkyl such as methyl, ethyl and the like. Further, in said formulae the recurring unit indices m, n, o and p are defined by

Art Unit: 1713

numerical ranges consistent with an average chain length within claim 7; i.e., at least about 100 (col. 3, lines 61-63), preferably about 300 (col. 8, lines 11-12); or, per claims 15 and 16, the sum of n, o and p is equal to or greater than about 200 or about 500.

Thus, it is concluded that one of ordinary skill in the art would have been led by Han et al to select $-\text{SOR}_1$ or $-\text{SO}_2\text{R}_1$ as the leaving group D in any of the disclosed formulae II – VI and control the frequency of recurring units therein to obtain an average chain length as claimed. One would have been so motivated by a reasonable expectation of obtaining another precursor polymer utile in the applications contemplated by the patentees (e.g., forming conducting articles and coatings; see col. 1, lines 11-15).

Accordingly, the subject matter of claim 7 is deemed to have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made.

Claims 1-3 and 8 would be allowable if amended or rewritten to overcome the rejection under 35 U.S.C. 112 set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: The claimed method for preparing a polymer which comprises structural units of formula (I) starting with a compound having the formula (II) as per claim 1, is not disclosed nor fairly suggested in any prior art document(s) located or identified by the examiner as of the date of this Office action; nor is a composition of polymers with

Art Unit: 1713


structural units having the formula (IX) and "first" and "second" fractions as defined in claim 8.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FMTeskin/11-01-04


FRED TESKIN
PRIMARY EXAMINER
1713